REMARKS

This Amendment responds to the Office Action mailed June 16, 2004. No new matter is believed to be added to application by this Amendment.

Entry of Amendment

Entry of this Amendment under 37 C.F.R. §1.116 is respectfully requested because it places the application into allowance. Alternately, entry is requested because it places the application in better form for appeal.

Status of the Claims

Claims 1-34 are pending in the application. Claims 20-33 have been withdrawn from consideration by the Examiner. Support for the amendments to claim 1 can be found in paragraph 0093 at page 17 of the specification. Claim 11 has been amended to improve its language.

Rejection Under 35 U.S.C. §102(e) Over Schmidt

Claims 1-19 and 34 are rejected under 35 U.S.C. §102(e) as being anticipated by Schmidt (U.S. Patent 6,482,281). Applicants traverse.

The Present Invention and Its Advantages

The present invention pertains to a releasable adhesive that can be removed with no residue at small peel-off angles. One of the important aspects of the invention lies in that the adhesive has a tear resistance greater than 800%. The invention finds a typical embodiment in claim 1:

> 1. A hot-melt adhesive comprising a non-pressure-sensitive adhesive that is fluid at application temperatures and that is removable, residue-free, by peeling at small peel angles, wherein said adhesive contains additives selected from the group consisting of fillers, stabilizers, dyes, carbon black, and moisture absorbents, said adhesive also containing the following:
> a) thermoplastic elastomers that may be grafted,
> b) grafted poly-α-olefins,
> c) polyisobutylene or a softening oil,
> d) adhesive resin, and
> e) end block resin,
> wherein the adhesive has a tear resistance greater than 800%.

Distinctions of the Invention over Schmidt

Schmidt pertains to hot-melt adhesives for vehicle lights or vehicle headlamps. The hot-melt adhesives of Schmidt are characterized by containing: "a) from 0.5 to 15% by weight of optionally grafted thermoplastic elastomers; b) from 5 to 40% by weight of optionally grafted poly-.alpha.-olefins except polyisobutylene; c) from 5 to 45% by weight of adhesive resins; and d) from 5 to 55% by weight of polyisobutylenes." See Abstract of Schmidt.

Schmidt fails to disclose a hot melt that can be removed without residue at low peel angles. Schmidt additionally fails to disclose a tear resistance of greater than 800%.

Schmidt's failure to have a high tear resistance and good peel properties can be understood from the formulation differences between Schmidt and the present invention. The Examples of Schmidt use 20 to 32.5% by weight of α-olefin. In contrast, the Comparative Examples of Schmidt use 5 to 15% by weight of α-olefin.

In comparison, the Example of the invention uses 6% by weight of α-olefin (see page 31 of the specification), which falls near the lower end of the range of the Comparative Examples of Schmidt.

The Comparative Examples of Schmidt, however, fail to anticipate the invention because the composition of all three Comparative Examples differ from the invention as follows: i) Comparative Examples 1 and 3 do not contain more than 1% of thermoplastic elastomers, and ii) Comparative Example 2 contains more than twice the amount of α-olefin than the Example of the present invention.

As a result, these fundamentally different formulative approaches causes Schmidt to teach away from the invention. Particularly, the technology of Schmidt would utterly fail to produce a tear resistance of greater than 800%, such as is set forth in instant claim 1 of the invention.

Further, the Examiner asserts at page 2, lines6-9 of the Office Action:

> Applicant has argued that Schmidt fails to disclose a hot melt that can be removed without residue at low peel angles. It is the position of the examiner that, since the compositions of Schmidt read on those of the rejected claims, the hot melts of Schmidt would inherently possess applicants' peel properties.

However, the failure of the formulations of Schmidt to achieve the properties of the invention has been discussed above. Even if these properties could be alleged to be inherent, the claims would still be patentable.

Accidental results not intended and not appreciated do not constitute anticipation. Eibel Processing Co. v. Minnesota and Ontario Paper Co., 261 US 45 (1923); Mycogen Plant Science, Inc. v. Monsanto Co., 243 F.3d 1316, 1336, 5 USPQ2d 1030, 1053 (2001). Further, the Federal Circuit stated in In re Robertson:

> [T]o establish inherency, extrinsic evidence must make clear that the missing descriptive matter was necessarily present in the thing described in the reference, and would be so recognized by persons with ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a set of circumstances is not sufficient. In re Robertson, 49 USPQ2d 1949 (Fed. Cir. 1999).

Further, it has been held that the mere fact that a certain thing may result from a given set of circumstances is not sufficient, and occasional results are not inherent. MEHL/Biophile International v. Milgraum, 52 USPQ2d 1303 (Fed. Cir. 1999).

As a result, the low angle peel and tear strength of greater than 800% set forth in claim 1 are clearly neither anticipated nor suggested by Schmidt. Claims depending on claim 1 are patentable for at least the above reasons.

This rejection is overcome and withdrawal thereof is respectfully requested.

Drawings

The Examiner has indicated that the drawing figures are acceptable in the Office Action mailed June 16, 2004.

Foreign Priority

The Examiner acknowledged foreign priority in the Office Action mailed June 16, 2004.

Information Disclosure Statements

The Examiner is thanked for considering the Information Disclosure Statement filed February 20, 2001 and for making the initialed PTO-1449 form of record in the Office Action mailed November 24, 2003. The Examiner is thanked for considering the Information Disclosure Statement filed February 24, 2004 and for making the initialed PTO-1449 form of record in the application in the Office Action mailed June 16, 2004.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Reg. No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By _____
James T. Eller, Jr., #39,538

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

JTE/REG/jls
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